

## **REMARKS**

Claims 1-3, 5, 7, 9, 10, 18-20, and 22 are pending in the application. This Response is further to the Amendment After Final filed March 1, 2010, which included claim amendments and is incorporated by reference herein. Applicant respectfully requests that the Examiner reconsider and withdraw the rejections in view of Applicant's amendments and remarks set forth in the Amendment After Final and the remarks set forth herein.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-6, 9-13, 16, and 18-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lappe et al. (U.S. Pat. No. 5,565,054) in view of Vaughn et al. (U.S. Pat. No. 6,983,686). This rejection is respectfully traversed for the reasons set forth below, as well as those set forth in Applicant's Amendment After Final filed March 1, 2010.

The Lappe et al. reference is directed to a device and method for transferring a foil film to a base material covered in select areas with an adhesive. The transfer takes place by pressing the foil film against the base material and then removing the film such that the foil film remains adhered to the areas of the base material where the adhesive was applied. No foil remains at the areas where the adhesive was not applied.

The Vaughn et al. reference is directed to printing and embossing images at *different* areas of a stretchable substrate, such as paper towel. Vaughn et al. does not disclose or suggest use of a transfer film for transferring foil onto an adhesive previously applied to a substrate. Accordingly, Vaughn et al. does not

disclose or suggest drying such an adhesive prior to printing or stamping as generally claimed by Applicant in Independent Claims 1, 18, and 19. Even if a transfer film was used to provide patterns on the paper towel of Vaughn et al., the reference only discloses printing and embossing at different locations, thus eliminating the need for a drying step or device, as generally claimed by Applicant in Claims 1, 18, and 19. The Vaughn et al. reference thus teaches away from the claimed drying step or device. One skilled in the art would not have been motivated to combine the teachings of Vaughn with those of Lappe for these reasons.

The Office Action's assertion that one skilled in the art would have been motivated to combine the references in order to "provide the printed product of Lappe with additional desirability [and] functionality through the embossed and printed features" is an unsupported, conclusory statement that is insufficient to support an obviousness rejection. See 12-1-2009 Office Action at 4. It is well established that rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Citing KSR Int'l. Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 at 1396 (2007). A claim "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.*

Because one skilled in the art would not have combined the references for the reasons set forth above, the Office Action's combination is further improper because it is based on impermissible hindsight. *In re Warner*, 379 F.2d 1011,

1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967) (obviousness rejection improper when based on speculation, unfound assumptions, and hindsight reconstruction to fill deficiencies in the factual basis of the rejection).

Even if there was motivation to combine and modify the references as set forth in the Office Action, the modification would not be sufficient to render the claims obvious because it would impermissibly change the device disclosed in Lappe and render the resulting device unsatisfactory for its intended purpose. See M.P.E.P. § 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification;" "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.").

Combining Lappe et al. with Vaughn et al. to provide the device/method of Lappe et al. with in-line embossing and printing without a specific drying step or drying device, as generally called for in Independent Claims 1, 18, and 19, will cause portions of the foil to separate from the still wet adhesive, thereby damaging the transferred foil and resulting in an unusable product. Combination of Lappe et al. and Vaughn et al. would thus be improper.

Combination of Lappe et al. and Vaughn et al. would also be improper because the embossed images 20 of Vaughn provide the paper towel with an uneven surface for the adhesive and foil film. Applying the foil film to an uneven surface can damage the foil film and/or make it difficult to retain the foil film to the

substrate via the adhesive. Such an uneven surface can cause an image printed thereon to be distorted and/or damaged. Further, printing or embossing a transfer film in-line without a drying device or drying step, as with the proposed combination, would damage the transferred foil because the wet adhesive would be unable to adequately secure the transferred foil during the printing and embossing.

Combination of the Lappe et al. and Vaughn et al. references is thus improper because one skilled in the art would have had no motivation to combine the references, the combination is based on impermissible hindsight, and the device resulting from the proposed combination would be inoperable for its intended use. For the reasons set forth herein and in Applicant's Amendment After Final filed March 1, 2010, which is incorporated herein by reference, Applicant respectfully requests reconsideration and withdrawal of this Section 103 rejection of independent Claims 1, 18, and 19, as well as those claims dependent therefrom.

### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication

will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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